

REMARKS/ARGUMENTS

The office action of March 29, 2004, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 16-46 are now pending in this application. Claims 16, 17, 19-21, 24-28, 30, 31, 34, and 37 are amended, and new claims 45 and 46 are added.

Preliminarily, Applicants note with appreciation the Examiner's indication that the application contains allowable subject matter. Specifically, it appears that claim 31 has been objected to only for being dependent upon a rejected base claim. Claim 31 has therefore been so amended to incorporate all the features of independent claim 25, and it is therefore respectfully submitted that independent claim 31 is in condition for allowance.

Non-Art Based Rejections

Claims 16-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Independent claims 16 and 25 are amended, and it is believed that this rejection is now moot.

Art-Based Rejections

Claims 16-30 and 32-44 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,611,349 to Vogt et al. ("Vogt"). Claims 19, 27, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vogt in view of U.S. Patent No. 6,084,688 to Stumbo et al. ("Stumbo").

All of the independent claims refer to an encapsulated PostScript (EPS) file. However, Vogt fails to teach or suggest an EPS file. Vogt only refers to a PostScript file.

Nor is it inherent that Vogt uses an EPS file. The Office Action states that EPS reads on a PostScript file, but this is not necessarily true. A PostScript file *may* be in the form of an EPS file, but this is not always the case. The fact that a certain characteristic *may* be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112. Inherency may not be established by probabilities or possibilities. MPEP 2112; *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The allegedly inherent characteristic must *necessarily* flow from the teachings of the applied prior art. MPEP 2112; *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In the present case, the use of an EPS file does not necessarily flow from the teachings of Vogt.

The dependent claims are also allowable over Vogt for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein. In addition, the proposed combination of Vogt and Stumbo still fails to teach or suggest an EPS file as claimed.

Moreover, Applicants respectfully submit that the proposed modification of Vogt with Stumbo also does not result in using PostScript Level 1 as recited in claims 19, 27, and 40. For example, claim 19 recites that the second EPS file is a Level 1 PostScript file. Referring back to its independent claim, the second EPS file is created by converting a PDF to the second EPS file. Stumbo, on the other hand, discloses *decomposing, not creating*, a PostScript1 file. (Stumbo, col. 7, lns. 43-44). Thus, the proposed modification of Vogt with Stumbo would result in, at most, decomposing a Level 1 PostScript file, not creating the second file as a Level 1 PostScript file.

In addition, the proposed motivation for combining Vogt with Stumbo is improper. The Office Action states that one would have modified Vogt by the teaching of Stumbo in order to improve the output of the jobs to the printing apparatus. First, there is nothing in Vogt or Stumbo to suggest that using Level 1 would result in an improvement. Second, Vogt refers to Levels 2 and 3. (Vogt, col. 13, lns. 38-40). There is nothing in Vogt or Stumbo to have motivated one to have *reduced* the level to a *less* advanced level. Indeed, such a change, if even possible, would most likely have reduced the effectiveness of Vogt and not have improved its output.

For at least these reasons, Applicants respectfully submit that all of the pending claims are allowable.

Independent Claim 31

In addition, because the Office Action has not asserted any art-based rejection of claim 31, it appears that the Examiner considers claim 31 to otherwise be in condition for allowance. Claim 31 is therefore rewritten in independent form and to include minor non-substantive terminology changes made to independent claim 25.

Conclusion

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner have any questions or require additional information, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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